

REMARKS

Reconsideration of this Application is respectfully requested in light of the amendments provided below. Claims 35-40 and 44-59 are pending. Claims 48-59 have been withdrawn from consideration as directed to a non-elected invention. Claim 35 has been amended. No new matter has been added.

Objection to the Specification

The specification remains objected to based on the use of the trademark GVAX. The specification has been amended as set forth above. A generic description for the term GVAX has been added to the specification by way of amendment, thereby obviating this basis for rejection.

Rejection under 35 U.S.C. §102(b).

Claims 35, 37, 38 and 40 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Wollin et al. (Radiother Oncol. 1989 Jul;15(3):285-93.) for reasons stated on pages 3 and 4 of the Office Action. Applicants respectfully traverse the rejection.

Wollin et al. is cited as disclosing a composition comprising irradiated PC3 or DU145 cells and the Office Action states that either Lang et al. (Int. J. Can. 59(2): 235-241; 1994 (abstract) or Rocklin et al. (Anticancer Res. 16(2): 557-563; 1996) teach that PC3 or DU 145 express GM-CSF.

For anticipation under 35 U.S.C. § 102, the reference "must teach every aspect of the claimed invention either explicitly or impliedly. Any feature not directly taught must be inherently present." (MPEP §706.02). "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." Verdegaal Bros. v. Union Oil Co. of California, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

The Wollin et al. abstract discloses irradiation of PC3 and DU145 cells.

Lang et al. (abstract) discloses that "GM-CSF-like material" was produced by both DU145 and PC-3 cells but not by LNCaP.

Rocklin et al. discloses that DU145 and PC3 secrete granulocyte-macrophage colony-stimulating factor (GM-CSF), while GM-CSF was not identified in LNCaP cells.

As set forth in M.P.E.P. § 2131 and Verdegaal Bros. v. Union Oil Co. of California, for anticipation to lie, each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. None of Wollin et al., Lang et al. or Rocklin et al. teach all the features of the claims. More specifically, the cited references, individually or in combination fail to disclose a proliferation-incompetent cell engineered to express GM-CSF selected from the group consisting of LnCaP, PC3 and DU145, as presently claimed.

Thus Wollin et al., Lang et al. or Rocklin et al., individually and in combination lack explicit description of the structural features of the invention as required for anticipation under 35 U.S.C. § 102(b).

Accordingly, withdrawal of the rejection under 35 U.S.C. § 102(b) is respectfully requested.

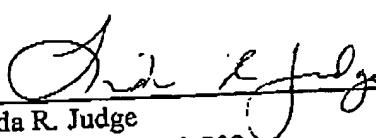
CONCLUSION

Applicants respectfully request that the Examiner reconsider all presently outstanding rejections and that they be withdrawn. It is believed that a full and complete response has been made to the outstanding Office Action and, as such, the present application is in condition for allowance.

If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to contact Linda R. Judge (Reg. No. 42,702) at 415-836-2586.

Respectfully submitted,

DLA PIPER RUDNICK GRAY CARY US LLP



Linda R. Judge
Registration No. 42,702

153 Townsend St., Suite 800
San Francisco, CA 94107
Telephone No. (415) 836-2500
Facsimile No. (415) 836-2501